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| 10/766,419 | 01/28/2004 | Edward L. Sinofsky | 3565.1000-000 | 2912 |
| 21005 | 7590 | 11/29/2006 | EXAMINER | |
| HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133 | | | REHM, ADAM C. | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2875 | |

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,419

Applicant(s)

SINOFSKY, EDWARD L.

Examiner

Adam C. Rehm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 48-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 17, 18, 20, 22, 23, 26, 40, 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649) and NORTHROP ET AL. (US 4,924,368) and DUPONT (US 3,673,401). ZOU substantially discloses the claimed invention including a flat/linear panel luminaire apparatus/system (300, Fig. 9) having:

- A cold-cathode fluorescent light source/chemiluminescent reaction (252, Fig. 8, Column 14, Line 62);
- A transparent, acrylic/dielectric insulating sleeve surrounding the light source (256, Column 8, Lines 40-43;);
- A planar waveguide having an edge in contact with the sleeve and receiving light through [a gap in] the sleeve, the planar waveguide emitting the received light through a planar surface and self-contained (316, Fig. 9; Column 9, Lines 48-54); and
- A reflector surrounding a substantial portion of the sleeve and directing light into one edge of the guide (258 illustrates a reflector surrounding the

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inside surface of sleeve 256) with the reflector made of a specular/porous thin polymer film or PTFE sheet (Column 5, Line 51-Column 6, Line 5).

2. ZOU does not disclose (1) a transparent sleeve allowing light from the light source to pass from an inner surface of the sleeve to an outer surface; or (2) a thermal insulating sleeve.

3. Regarding (1), NORTHROP teaches a fluorescent light with protective, transparent shield/sleeve for the purpose of protecting the light (40; see Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to modify ZOU and use the sleeve as taught by NORTHROP in order to protect the light.

4. Regarding (2), while ZOU's sleeve is likely thermally insulating given the disclosed listing of possible materials, DUPONT specifically teaches the use of a sleeve/jacket for a fluorescent lamp made of a material having good heat resistance (see Summary). It would have been obvious to one of ordinary skill in the art at the time of invention to modify ZOU and use the heat resistant material as taught by DUPONT in order to provide a durable jacket that is resistant to heat.

5. Claims 4, 5, 8, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649) in view of ATO (US 6,935,766). ZOU ET AL. discloses the claimed invention as cited above, but does not specifically disclose an adhesive or friction connector for coupling said reflector/insulating sleeve to the waveguide. However, ATO teaches a double-sided adhesive tape for coupling a reflector and light guide (Column 4, Lines 56-59). It would have been obvious to one of ordinary skill in the art at the time of invention to modify ZOU ET AL. and use the

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adhesive tape as taught by ATO in order to couple the reflector/insulating sleeve (as a unit) and the light guide.

6. Claims 6, 7, 29, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649) in view of ATO (US 6,935,766) as applied above to Claims 4, 5, 8, 27 and 28. ZOU ET AL. and ATO disclose the claimed invention as cited above including an adhesive tape for coupling a reflector to a light guide (ATO, Column 4, Lines 56-59), but do not specifically disclose a type of tape. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use segmented metalized, vinyl or polyester tape, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Moreover, Applicant has not disclosed that a specific tape solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the adhesive tape disclosed in ATO. Even further, metalized tape, which requires segmentation for use, in addition to vinyl and polyester tapes are commonly used and easily assessable. It would have been obvious to one of ordinary skill in the art at the time of invention to use a common and readily assessable tape in ATO.

7. Claims 9, 10, 14, 15, 32, 33, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649) as applied to claims 1 and 22 and further in view of MURASE ET AL. (US 5,408,387). ZOU ET AL. discloses the claimed invention, but does not specifically disclose a back panel/thin polymer film specular

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reflector sheet for the purpose of limiting pass through light emissions. However, MURASE teaches a thin polymer film back panel (2, Column 3, Line 20) having ink dots (20) that increase in percentage correspondingly to increased distance from a light source for the purpose reflecting light uniformly (Column 3, Lines 35-43). It would have been obvious to one of ordinary skill in the art at the time of invention to modify ZOU ET AL. and use the back panel and ink dots as taught by MURASE in order to provide a more efficient edge-lit light guide.

8. Claims 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649). ZOU ET AL. discloses the claimed invention including sleeve 256 formed of shrink tubing/polymer (Column 9, Line 13), but does not specifically disclose a sleeve made of a fluoropolymer tube. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a fluoropolymer enclosure, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Moreover, Applicant has not disclosed that a fluoropolymer enclosure solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the reflectors disclosed in ZOU.

9. Claims 12 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649). ZOU ET AL. discloses the claimed invention including sleeve (256), but does not specifically disclose a sleeve having an index of refraction of claimed or a waveguide made of acrylic. However, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made to construct a sleeve with the index of refraction as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Moreover, given that the sleeve and waveguide are both transparent, as previously disclosed, it is reasonable to assume that for efficiency purposes, both elements could be constructed of the same material, thus having equal indexes of refraction.

10. Claims 13, 19, 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649) in view of YU ET AL. (US 6,979,112). ZOU ET AL. discloses the claimed invention including a waveguide (316), but does not specifically disclose an acrylic waveguide or a waveguide having grooves. However, YU teaches a transparent, acrylic waveguide with a plurality of concave surfaces/grooves to provide a light incident surface that facilitates the entry of light into the waveguide (Column 3, Lines 20-35). It would have been to one having ordinary skill in the art at the time the invention was made to make the waveguide of acrylic and with grooves, by which at least some of the received light would enter at about the critical angle, for purposes of obtaining the well known advantages of acrylic, e.g. transparent material with high glass transition temperature, and grooves, e.g. more efficient use of light.

11. Claims 16 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649). ZOU ET AL. discloses the claimed invention

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including a old-cathode fluorescent light source (252, Fig. 8, Column 14, Line 62), but does not specifically disclose a removable light source. However, it would have been to one having ordinary skill in the art at the time the invention was made to make the light source removable for purposes of maintenance and replacement in addition to the fact that it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

12. Claims 21, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649) in view of applicant's admitted prior art. ZOU ET AL. discloses the claimed invention as cited above, but does not specifically disclose a waveguide, light source and sleeve formed as a self-contained unit capable of removable insertion into a display structure/picture frame. However, applicant admits that such use is known in the art (Page 1, Lines 23-24) for the purpose of enhancing the display of graphical or visual information (Page 1 Lines 5-7). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the waveguide, light source and sleeve of ZOU ET AL. into a self-contained unit capable of removable insertion into a display structure/picture frame as taught by applicant's admitted prior art in order to enhance the display of graphical or visual information.

13. Claims 44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649), ATO (US 6,935,766), NORTHROP ET AL. (US 4,924,368) and DUPONT (US 3,673,401). ZOU ET AL. discloses a planar waveguide system for emitting light with reduced loss (300, Fig. 9 illustrates a waveguide that reduces light loss) having:

- A cold-cathode fluorescent light source (252, Fig. 8, Column 14, Line 62);
- A transparent, acrylic/dielectric insulating sleeve surrounding the light source (256, Column 8, Lines 40-43);
- A planar waveguide having an edge in contact with/adjacent to the sleeve and receiving light through [a gap in] the sleeve, the planar waveguide receiving the light through an incident edge and emitting the received light through a planar surface (316, Fig. 9; Column 9, Lines 48-54); and
- A reflector surrounding a substantial portion of the sleeve and directing light into one edge of the guide (258 illustrates a reflector surrounding the inside surface of sleeve 256) with the reflector made of a specular/porous thin polymer film or PTFE sheet and enabling contact between the light source and sleeve (Fig. 9; Column 5, Line 51-Column 6, Line 5).

14. ZOU discloses the claimed invention, but does not specifically disclose means for coupling said reflector/insulating sleeve adjacent to the waveguide edge. However, ATO teaches a double-sided adhesive tape for coupling a reflector and light guide (Column 4, Lines 56-59). It would have been obvious to one of ordinary skill in the art at the time of invention to modify ZOU and use the adhesive tape as taught by ATO in order to couple the reflector/insulating sleeve (as a unit) and the light guide.

15. ZOU does not disclose a transparent sleeve allowing light from the light source to pass from an inner surface of the sleeve to an outer surface. However, NORTHROP teaches a fluorescent light with protective, transparent shield/sleeve in contact with the light for the purpose of protecting the light (40; see Abstract). It would have been

obvious to one of ordinary skill in the art at the time of invention to modify ZOU and use the sleeve as taught by NORTHROP in order to protect the light.

16. ZOU does not disclose a thermal insulating sleeve effectively enabling contact between an outer surface of the sleeve and waveguide. While ZOU's sleeve is likely thermally insulating given the disclosed listing of possible materials, DUPONT specifically teaches the use of a sleeve/jacket for a fluorescent lamp made of a material having good heat resistance (see Summary). It would have been obvious to one of ordinary skill in the art at the time of invention to modify ZOU and use the heat resistant material as taught by DUPONT in order to provide a durable jacket that is resistant to heat. Further, Applicant's claim language recites that the sleeve *effectively enables* contact between the sleeve and waveguide. Notably, the language does not positively recite actual contact between the elements. Therefore, it is the position of the Examiner that given the use of DUPONT's thermal sleeve, it is enabled for such contact and other decreased proximity between the sleeve and heat-sensitive elements.

17. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649) in view of ATO (US 6,935,766) as applied to claim 44. ZOU ET AL. and ATO disclose the claimed invention including sleeve (256), but do not specifically disclose a sleeve having an index of refraction of claimed or a waveguide made of acrylic. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct a sleeve with the index of refraction as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only

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routine skill in the art. *In re Aller*, 105 USPQ 233. Moreover, given that the sleeve and waveguide are both transparent, as previously disclosed, it is reasonable to assume that for efficiency purposes, both elements could be constructed of the same material, thus having equal indexes of refraction.

18. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over ZOU ET AL. (US 6,186,649) and ATO (US 6,935,766) as applied to claim 44. ZOU ET AL. in view of ATO disclose the claimed invention including sleeve 256 formed of shrink tubing/polymer (Column 9, Line 13), but does not specifically disclose a sleeve made of a fluoropolymer tube. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a fluoropolymer enclosure, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Moreover, Applicant has not disclosed that a fluoropolymer enclosure solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the reflectors disclosed in ZOU ET AL.

Response to Amendment

19. Applicant's amendment filed 10/2/2006 has been received.

Response to Arguments

20. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

21. Applicant's arguments revolve around the new claim language requiring the insulating sleeve to be a thermal insulating sleeve. Given the new prior art, those arguments are believed to be addressed.

22. Applicant asserts that the amendment of May 31, 2006 specified that the reflector was located at the outside of said sleeve. Examiner acknowledges the recitation in the claims and responds that the references NORTHROP and DUPONT have sleeves intended to be employed flush with the outer surface of the light source and therefore between the source and reflector. It is along this vein that Examiner maintains the rejection of said language.

23. Applicant asserts that ATO does not disclose a sleeve as claimed. Examiner concurs. ATO was not employed in order to illustrate such, but rather to illustrate the obviousness of utilizing a double-sided adhesive tape to connect elements.

24. Applicant repeats arguments regarding the new claim language requiring the insulating sleeve to be a thermal insulating sleeve. Given the new prior art, those arguments are believed to be addressed.

25. The rejections are maintained.

Conclusion/Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam C. Rehm whose telephone number is 571.272.8589. The examiner can normally be reached on M-F 9-5:30 EST.

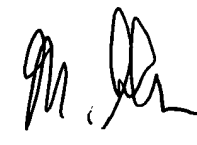
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571.272.2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ACR
11/23/2006


Thomas
Primary Examiner


M. Sember
Examiner